

- Group II: claim 1 – 42, drawn to compositions and methods in which the fluoroalkene contains atoms other than C, H, and F.

In addition, the Office has required that a single species of fluoroalkene be selected for prosecution on the merits. Applicants provisionally elect, with traverse, the claims of Group I for examination, and provisionally select, with traverse, species A for initial search and examination purposes.

Claims 1 – 42 are currently pending.

**TRAVERSAL OF THE RESTRICTION REQUIREMENT:**

Applicants respectfully traverse the Office's restriction requirement because it usurps Applicants' right to have each claim of the application examined on its merits.

The Office asserts that the inventions, as delineated above, are distinct and "have acquired separate status in the art because of their recognized divergent subject matter." Office Action dated 09/23/04 p. 2. However, the Office has not demarcated the alleged separate inventions based upon groupings of different claims, but instead argues that each claim describes more than one distinct invention. For example, original claim 1 is directed to a liquid composition comprising, among other things, fluoroalkene containing 3 to 4 carbon atoms and at least one but no more than two double bonds. Yet with respect to the fluoroalkene constituent in claim 1, the Office has required that the Applicants choose either (1) fluoroalkenes consisting of C, H, and F, or (2) fluoroalkenes containing atoms other than C, H, and F, even though claim 1 does not describe such a distinction. Moreover, the Office has not provided any substantial reasons in support its

conclusion that the claimed subject matter is “divergent” and, in fact, admits that all of the alleged inventions are classified under class 252, subclass 68.

As an initial matter, Applicants point out that an applicant has the right “to claim his invention with the limitations he regards as necessary to circumscribe that invention,” and “to have each claim examined on its merits.” *See In re Weber*, 580 F.2d 455, 458-59 (CCPA 1978). In *Weber*, the court held that a rejection under § 121 violates the basic right of the applicant to claim his invention in the manner that he chooses. In support of its decision, the court stated that:

If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a *single claim* is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to Restrict an Application to one of several claimed inventions when those inventions are found to be “independent and distinct.” It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to Reject a particular Claim on that same basis.

*Id.* at 458 (emphasis added) (*See also In re Haas*, 580 F.2d 461 (CCPA 1978) (holding that § 121 could not be used as the basis for rejecting a single claim or compelling its replacement by a plurality of narrower claims before examination on the merits would have been made)).

The Office, therefore, cannot require an applicant to amend a claim without first examining that claim on its merits. Yet the Office’s restriction of

claim 1 to either (1) composition and methods in which the fluoroalkene consists of C, H, and F; or (2) composition and method in which the fluoroalkene contain atoms other than C, H, and F, is tantamount to such a restriction. Therefore, the Office has violated the Applicants' right to claim their invention as they choose. For at least this reason, Applicant respectfully traverses the Office's restriction requirement.

Applicants also traverse the restriction requirement because the Office has not reasonably shown that it will incur a serious burden with respect to examination of the claims as presented in a single application.

For a restriction between patentably distinct inventions to be proper, the Office must demonstrate that (1) the inventions are independent or distinct as claimed; and (2) there must be "a serious burden on the examiner." MPEP § 803.01. Moreover, the Office must provide reasons and/or examples to support its conclusions that these two criteria have been satisfied.

With respect to the second criteria, the Office has not demonstrated that the examiner would incur a serious burden in the examination of the present application. The Office has not provided any reasons or examples to support why such a "serious burden" would exist and, in fact, the Office's restriction is completely devoid of any explanation or comment regarding its burden.

Applicants assert that the present application would not present the Office with a serious burden of examination. As the Office readily indicates, all of the claims are directed to inventions classified in class 252, subclass 68. Thus, examination of the

application, including any required prior art searches, would not present an unreasonable, let alone serious, burden for the examiner.

Applicants request that the Office reconsider its requirement for restriction in view of the above-mentioned arguments.

Applicant believes that no fees are currently required to further prosecute this application. However, if any such fees are required, the Office is authorized to charge the necessary amount to Deposit Account No. 19-5425.

The Office is invited to contact the undersigned counsel in order to further the prosecution of this application in any way.

Respectfully submitted,

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